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Attorney Docket No. **P51333**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Marino et al.	April 4, 2008
Serial No.:	10/509214	Group Art Unit: 1617
Filed:	September 24, 2004	Examiner: S. WANG
For:	COMPOUNDS AND METHODS	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO REQUIREMENT FOR
RESTRICTION UNDER 35 U.S.C. §§121 and 372

Sir:

This paper is in response to the Restriction Requirement dated April 2, 2008, setting forth a thirty (30) day shortened statutory period for reply. Claims 1-4 are pending in the application. Claims 1-4 are subject to restriction and/or election requirement. As this response is timely filed within the shortened statutory period for response of thirty (30) days, no fee is thought to be required. However, if the U.S. PTO deems a fee is required, the Commissioner is hereby given authority to charge such requisite fee to Deposit Account No. 19-2570. Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the following remarks.

Restriction is required under 35 U.S.C. §§121 and 372. In particular, the Examiner asserts that the application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1. Applicants are required to make an election among two allegedly distinct inventions, namely Group I, claim(s) 1-4 (in part), drawn to method of treating bacterial infections by administering a compound defined by formula (IA), wherein X is S, R1 is a group with a thienyl or a furyl moiety; one of R2 and R3 is a group with a phenyl moiety, and the other one is hydrogen or C1-3 alkyl; Group II, claim(s) 1-4 (in part), drawn to method of treating bacterial infections by administering a compound defined by formula (IA), wherein X is O, R1 is a group with a thienyl or a furyl moiety; one of R2 and R3 is a group with a phenyl moiety, and the other one is hydrogen or C1-3 alkyl; Group III, claim(s) 1-4 (in part), drawn to method of treating bacterial infections by administering a compound defined by formula (IA), wherein X is S, R1 is a group with a six-membered aromatic ring moiety; one of R2 and R3 is a group with a phenyl moiety, and the other one is hydrogen or C1-3 alkyl; Group IV, claim(s) 1-4 (in part),

drawn to method of treating bacterial infections by administering a compound defined by formula (IA), wherein X is O, R1 is a group with a six-membered aromatic ring moiety; one of R2 and R3 is a group with a phenyl moiety, and the other one is hydrogen or C1-3 alkyl; Group V, claim(s) 1-4 (in part), drawn to method of treating bacterial infections by administering a compound defined by formula (IA), wherein X is S, R1 and R2 are not those defined in groups I and III; and Group VI, claim(s) 1-4 (in part), drawn to method of treating bacterial infections by administering a compound defined by formula (IA), wherein X is O, R1 and R2 are not those defined in groups I and III.

Applicants respectfully traverse the requirement for restriction initially because it does not comply with the unity of invention standard set by the PCT, and secondly, because it is improper under U.S. restriction practice since there would be no additional burden upon the Examiner to search all inventions together.

The standard applicable to the instant application is not one of restriction practice under U.S. guidelines, but one of unity of invention under the PCT. In the instant case, no lack of unity of invention was found by the International Searching Authority or the International Preliminary Examining Authority, and all claims were searched and examined as one invention. The question of unity of invention may be reexamined only within the scope of rules of the Patent Cooperation Treaty (35 U.S.C. §372(b)), and restriction requirements made according to U.S. practice, which are more restrictive than the PCT regulations, are in error. PCT Article 27 ("no national law shall require compliance with requirements relating to form or contents ... different from or additional to those which are provided for in this Treaty and the Regulations").

PCT Rule 13.1 states that there exists unity of invention if the international application relates "to one invention only or to a group of inventions so linked as to form a single general inventive concept." Clearly the general inventive concept which links the alleged various inventions here is the structural class of compounds having a common pharmacological activity. PCT Rule 13.2 states that unity of invention shall be fulfilled where there is a technical relationship among those inventions involving one or more of the same or corresponding technical features, where the technical feature defines the contribution that each of the claimed inventions makes over the prior art. The special technical features shared by each of the various Groups which the Examiner has deemed distinct are (i) the triazole nucleus of the instant compounds, and (ii) the common inhibitors of bacterial methionineaminopeptidase activity of the compounds. Since the various compounds are related to the same underlying technical features, there is unity of invention and a restriction requirement is improper.

Furthermore, in accordance with U.S. practice, M.P.E.P. §803 mandates two criteria for a proper restriction requirement: (1) the inventions must be independent or distinct as

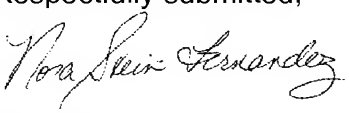
claimed; and (2) there must be a serious burden on the Examiner if restriction is not required.

It is urged that the above Groups are merely different embodiments of a single inventive concept for which a single patent should issue and do not constitute distinct inventions such as to require that the subject matter be prosecuted in separate patent applications. "Independent", according to M.P.E.P. §802.01, means that "there is no disclosed relationship between the two or more subjects disclosed." The subject matter of the Groups is clearly related, having arisen from a singular research effort, as related to novel compounds having a common structural core nucleus and having their genesis in a common pharmacological activity. Therefore, the Groups are not independent inventions within the meaning of §802.01. Furthermore, since the compounds have a core nucleus of structure there is not an undue burden on the Examiner with respect to searching the subject matter of the invention.

Therefore, in view of the foregoing and further in view of the interest of efficiency and cost savings to both Applicants and the PTO, reconsideration and withdrawal of the requirement for restriction are requested. However, Applicants provisionally elect, subject to the traverse set forth above, Group I, covering claim(s) 1-4 (in part), drawn to method of treating bacterial infections by administering a compound defined by formula (IA), wherein X is S, R1 is a group with a thienyl or a furyl moiety; one of R2 and R3 is a group with a phenyl moiety, and the other one is hydrogen or C1-3 alkyl. In the event the requirement is made final, Applicants hereby reserve the right to file one or more divisional applications directed to the non-elected subject matter.

Favorable reconsideration of claims 1-4, withdrawal of the requirement for restriction and allowance of this application with claims 1-4 are earnestly solicited.

Respectfully submitted,



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